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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/190,536	11/12/1998	JOHN J. DWYER	B653-024	6771

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/190,536

Applicant(s)

DWYER ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,8-11,18-21,23-27,29 and 35-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-11,18-21, 23-27, 29 and 35-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. **Claims 1, 9, 11, 19, 29, 35, 40, 42, 44-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terui et al. (US 5903,871) in view of Suzuki et al. (U.S. 5,986,568).

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Regarding **claims 1, 11 and 29**, Terui discloses a voice recording and reproducing apparatus, comprising:

a voice recording and reproducing apparatus (column 8, lines 61-63) (which reads on claimed "a portable digital audio recorder"), which includes memory means (38 on FIG. 6) for storing a plurality of voice data files (column 11, lines 38-39), the memory means storing an index information area (column 11, lines 33-34) (which reads on claimed "corresponding header data in association with each of the stored data files") (column 10, lines 59-65 and column 11, lines 28-49) [The files are stored with the header information recorded in the index information area];

a personal computer (column 8, line 1).

Terui fails to disclose means for transferring voice data files, another information processing device and means for interconnecting the personal computer with the other processing devices.

However, Suzuki teaches means for transferring one of the voice data files and the corresponding header data from the PDA (column 7, line 51) (which reads on claimed "portable recorder") to a server device (column 7, line 52) (which reads on claimed "the personal computer (column 7, lines 50-54) [The information is transferred by data communication].

an information processing device ( 30 on FIG. 27) other than the portable recorder and the personal computer [The fax is an other information processing device]; and

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means, interconnecting the personal computer with the other information processing device, (3 on FIG. 27) for permitting transmission of data from the personal computer to the other data processing device (column 8, lines 26-36);

wherein the personal computer reads the header data transferred to the personal computer (column 11, lines 6-12), and uses the header data to determine whether to transfer the corresponding voice data file to the other information processing device (column 22, lines 18-25) [The transfer is made according to the destination information in the header files].

Wherein the header data that is used to determine to transfer the corresponding voice data file to the other information processing device is indicative of an identify of the portable digital recorder (column 22, lines 58-65) [The personal allocated ID on the PDA side which the identity of portable digital recorder].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use other information transfer method and system of Suzuki in the invention of Terui.

The modification would offer the capability of transferring files from the portable audio recorder to the personal computer and transferring the information to another processing system based on the header files such as the system would determine the destination of the voice files recorded.

Regarding **claims 9 and 35** Terui and Suzuki discloses all the limitations of the **claim 9** as stated in the **claim 1** rejection.

In addition, Terui teaches a dictation system (column 5, lines 34-36).

Regarding **claim 19**, Terui and Suzuki disclose all the limitations of **claim 19** as stated in **claims 1 and 9** rejection.

Regarding **claim 40**, Terui and Suzuki disclose all the limitations of claim 40 as stated in claim 1 rejection.

In addition, Terui discloses a microphone (1 on FIG.1).

Regarding **claim 42**, Terui and Suzuki as applied to **claim 40** disclose all the limitations of **claim 42**.

Regarding **claim 44**, Terui and Suzuki as applied to **claim 1** rejection disclose the limitation of **claim 44**.

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Regarding **claim 45**, Terui and Suzuki as applied to **claim 1** differ from **claim 45** in that it fails to disclose the header is indicative of a subject matter.

However, Suzuki teaches the header data is indicative of a subject matter (column 12, lines 11-24).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the header is indicative of a subject matter of Suzuki in the invention.

Doing so the system would transmit voice data using the subject matter.

Regarding **claim 46**, Terui and Suzuki as applied to **claim 1** differ from **claim 46** in that it fails to disclose the header is indicative of a work type.

However, Suzuki teaches the header data is indicative of a work type (column 12, lines 11-24).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the header is indicative of a work type of Suzuki in the invention.

Doing so the system would transmit voice data using the type of disease.

3. **Claims 8, 18 and 41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terui in view of Suzuki and in further view of Salazar et al. (U.S. 5,774,841).

Regarding **claims 8 and 18**, Terui and Suzuki as applied to **claims 1 and 11** above differ from **claims 8 and 18** in that it fails to disclose other information-processing device is another personal computer.

However, Salazar teaches the other information-processing device is another personal computer (40 on FIG. 2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the other information-processing device as another personal computer of Salazar in the invention of Terui and Suzuki.

Doing so would send the commands over the communication path.

Regarding **claim 41**, Terui and Suzuki as applied to **claim 40** above differ from **claim 41** in that it fails to disclose information processing device as another personal computer.

However, Salazar teaches the one of the plurality of information processing devices selected by the personal computer is another personal computer (40 on FIG.2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use information processing device as another personal computer of Suzuki in the invention of Terui and Suzuki.

Doing so would transmit voice data to a computer.



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4. **Claims 10, 20-21, 23-25, 27 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terui in view of Suzuki and in further view of Bergeron et al. (US 5,033,077).

Regarding **claims 10, 20 and 36**, Terui and Suzuki as applied to **claims 1, 11 and 29** above differ from **claims 10, 20 and 36** in that it fails to disclose other information processing devices is a voice mail system.

However, Bergeron teaches a voice mail system (column 4, lines 29-34).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the voice mail of Bergeron in the invention Terui and Suzuki.

The modification would have the capability of transferring the voice data to a voice mail system such as the user would be able to listen to his voice mail message.

Regarding **claim 21**, Terui and Suzuki disclose all the limitations of claim 21 as stated in claim rejection in that it fails to disclose the information process as a voice mail system.

However, Bergeron teaches a voice mail system (column 4, lines 29-34).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use the voice mail of Bergeron in the invention Terui and Suzuki.

The modification would have the capability of transferring the voice data to a voice mail system such as the user would be able to listen to his voice mail message.

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Regarding **claim 23**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 23** in that it fails to disclose data, identifying a portable digital audio recorder.

However, Suzuki teaches the header data read by the personal computer includes data, which identifies the portable digital audio recorder ( "CORRESPONDING ITEM ADDRESS" on FIG.8).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a data, which identifies a portable digital audio recorder of Suzuki in the invention.

Doing so would transmit data to describe the item address.

Regarding **claim 24**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 24** in that it fails to disclose data, identifying an intended recipient.

However, Suzuki teaches the header data read by the personal computer includes data, which identifies an intended recipient for the voice data file corresponding to the header data ( "DATA PORTION" on FIG. 8).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a data, which identifies an intended recipient of Suzuki in the invention.

Doing so would transmit data to the appropriate recipient.

Regarding **claim 25**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 25** in that it fails to disclose data, identifying a subject matter.

However, Suzuki teaches the header data read by the personal computer includes data, which identifies a subject matter of the voice data file corresponding to the header data ( "CLASSIFICATION OF DATA" on FIG. 8).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a data, which identifies a subject matter of Suzuki in the invention.

Doing so would transmit data with specifications.

Regarding **claim 27**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 27**.

In addition, Terui discloses the one of the plural of information processing devices selected by the personal computer is a central dictation system (column 5, lines 34-36).

5. **Claim 26** is rejected under 35 U.S.C. 103(a) as being unpatentable over Terui in view of Suzuki in view of Bergeron and in further view of Salazar.

Regarding **claim 26**, Terui, Suzuki and Bergeron as applied to **claim 21** above differ from **claim 26** in that it fails to disclose information processing device as another personal computer.

However, Salazar teaches the one of the plurality of information processing devices selected by the personal computer is another personal computer (40 on FIG.2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use information processing device as another personal computer of Salazar in the invention of Terui, Suzuki and Bergeron.

Doing so would transmit voice data to a computer.

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6. **Claims 37-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Terui in view of Suzuki and in further view of Barker (US 5,398,220).

Regarding **claim 37**, Terui and Suzuki disclose all the limitations of the claim 37 as stated in claim rejection, in that it fails to disclose a speech recognition algorithm.

However, Barker teaches applying a speech recognition algorithm to the recipient information to generate recipient data (column 2, lines 1-7).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a speech recognition algorithm of Barker in the invention of Terui and Suzuki.

The modification would apply a speech recognition algorithm to the recipient information to generate recipient data transmit data to the device such as the system would recognized utterance in the voice files and route the files to destination.

Regarding **claim 38**, Terui, Suzuki and Barker as applied to **claim 37** above differ from **claim 38** in that it fails to disclose transferring the dictated information in the form of digital voice data.

However, Barker teaches the step of transferring the dictated recipient information from the recorder to the personal computer in the form of digital voice data (column 3, lines 17-28).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a digital voice data of Barker in the invention of Terui and Suzuki.

The modification would apply the step of transferring the dictated recipient information from the recorder to the personal computer in the form of digital voice data such as the system would transfer the voice in a digital form.

Regarding **claim 39**, Terui, Suzuki and Barker as applied to **claim 37** disclose all the limitations of **claim 39**.

7. **Claim 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker in view of Bergeron and in further view of Raji et al. (U.S. 5,812,882)

Terui and Suzuki as applied to **claim 40** above differ from **claim 43** in that it fails to disclose a local area network.

However, Raji teaches wherein the means for transmission of data from the personal computer to the data processing devices includes a local area network (column 33, lines 18-20).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to use a local area network of Raji in the invention of Terui and Suzuki.

Doing so would transmit voice data to the Ethernet.

### ***Response to Arguments***

8. Applicant's arguments with respect to **claims 1, 8-11, 18-20, 21-27, 29 and 35-46** have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



g.g.

September 2, 2002

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SUPERVISORY PATENT EXAMINER  
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